

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

On 5 March 2001

TOWNSEND and TOWNSEND and CREW, LLP

By: Malinda Adag, Jr.

Attorney Docket No.: 15280-315-100US
Client Reference No.: E-094-97/0f



Ext Off Time/Blot

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SETTARA CHANDRASEKHARAPPA et al:

Application No.: 09/380,337

Filed: March 6, 2000

For: MENI, THE GENE ASSOCIATED
WITH MULTIPLE ENDOCRINE
NEOPLASIA TYPE 1, MENIN
POLYPEPTIDES AND USES THEREOF

Examiner: J. Hunt

Art Unit: 1642

RECEIVED

MAR 13 2001

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION
REQUIREMENT

03/09/2001 HN00R1 00000010 201430 09380337
01 FC:115 110.00 CH

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement mailed January 4, 2001, Applicants elect to prosecute Group I, claims 1-8, 19-26, 28-33, and 36-37. A petition to extend time to respond for one month and the appropriate fee are submitted herewith.

The foregoing election is made with traverse, as the five groups set forth by the Examiner all stem from a common concept and theory, and are thus related. As such, prosecution of the claims of Groups I-IV would not place a substantially greater burden on the Examiner.

Moreover, Applicants respectfully submit that the unity of invention rule has been applied incorrectly in the present restriction requirement. The Action asserts that "inventions listed as Groups I-IV do not relate to a single inventive concept under the PCT rules. According to the Action, the claims lack the same or corresponding special technical features, which the Action perceives to mean that for Group I, the "special technical feature" is a nucleic acid; for Group II, a protein; for Group III; an antibody; and for Group IV, a method of detecting a protein. In this regard, it appears that the Action mistakes the "special technical feature" concept of the PCT rules to mean the particular embodiments of the invention.

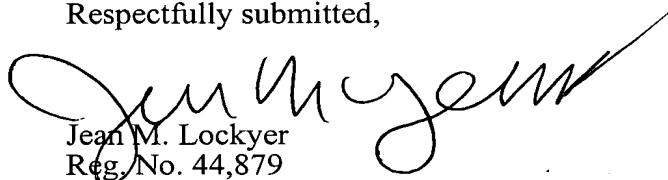


PCT rule 13.2 actually relates to the ~~features~~ which define the contribution that the invention, considered as a whole, makes over the prior art.¹ The contribution which the invention makes as a whole over the prior art is the discovery of a novel tumor suppressor gene that is associated with multiple endocrine neoplasia type I. All the embodiments of the invention are based on this discovery and that is their contribution over the prior art. Considered as a whole, they therefore share the same technical feature. That this interpretation of the "technical feature" requirement is correct is strongly supported by the fact that all the claims in the parent PCT application were searched together by the European Patent Office, whose examiners have been operating for years under the "unity of invention" rule. The Applicants respectfully submit that the unity of invention rule has been applied incorrectly in the present restriction requirement.

Based upon these considerations, Applicants respectfully withdrawal of the Restriction Requirement and consideration of all the claims together.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


Jean M. Lockyer
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
JML
SF 1196091 v1

¹ PCT Rule 13.2 states, in relevant part: "The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the claimed art."